

REMARKS

Claims 126-149, 151-166, 168-172, 174-176 and 202-204 are presented for examination.

Claims 126, 139, 154, 165, and 171 are proposed to be amended, per the Amendment

After Final Rejection dated March 15, 2007.

Applicants' undersigned attorney gratefully acknowledges the brief telephone Interview granted by the Examiner on April 4, 2007. Applicants' undersigned attorney suggested that the obviousness standard being applied by the Examiner to define "substantially the same invention" under 35 U.S.C. § 135(b)(2) was incorrect, and the examiner requested citations supporting applicants' interpretation. This is provided below.

Claims 126-149, 151-166, 168-172, 174-176 and 202-204 are rejected under 35 U.S.C. § 135(b) as being "made" more than one year after the publication of US 2002/0030039.

The examiner alleges that "Applicant did not copy claims from the pre-grant publication 2002/0030039 (pub date 4/14/02) within one year as required by 35 USC 135(b)(2). In fact, applicant did not "copy" the claims of US 2002/0030039, as prohibited by 35 U.S.C. § 135(b) ("A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.") Rather, the claims each include at least one substantive difference from the claims of the published application. Note that a standard of obviousness derived from 35 U.S.C. § 103 is irrelevant (MPEP 2304.02(c)):

The obviousness test is not the standard for determining whether the subject matter is the same or substantially the same. Rather the determination turns on the presence or absence of a different material limitation in the claim. These tests are distinctly different. The analysis focuses on the interfering claim to determine whether all material limitations of the interfering claim necessarily occur in a prior claim. In re Berger, 279 F.3d 975, 61 USPQ2d 1523 (Fed. Cir. 2002). If none of the claims which were

present in the application, or in a parent application, prior to expiration of the one-year period meets the "substantially the same subject matter" test, the interfering claim should be rejected under 35 U.S.C. 135(b). *In re McGrew*, 120 F.3d 1236, 43 USPQ2d 1632 (Fed. Cir. 1997). Note that the expression "prior to one year from the date on which the patent was granted" in 35 U.S.C. 135(b) includes the one-year anniversary date of the issuance of a patent. *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964).

In contrast, "An interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa." 37 C.F.R. § 41.203. Therefore, it is possible to have interfering claims under 37 C.F.R. 41.203 which do not claim "the same ..., or for the same or substantially the same subject matter". The test for interference is a two-way obviousness test, while the test under 35 U.S.C. § 135(b)(2) is a "different material limitation" test. MPEP 2307 provides:

In order for an application claim to be for "substantially the same subject matter" as a patent claim, it must contain all the material limitations of the patent claim.

Parks v. Fine, 773 F.2d 1577, 227 USPQ 432 (Fed. Cir. 1985), modified, 783 F.2d 1036, 228 USPQ 677 (1986). See also *Corbett v. Chisholm*, 568 F.2d 759, 196 USPQ 337 (CCPA 1977); *In re Sitz*, 331 F.2d 617, 141 USPQ 505 (CCPA 1964); *Stalego v. Heymes*, 263 F.2d 334, 120 USPQ 473 (CCPA 1959); *Rieser v. Williams*, 255 F.2d 419, 118 USPQ 96 (CCPA 1958); *Emerson v. Beach*, 215 F.2d 290, 103 USPQ 45 (CCPA 1955); *In re Tanke*, 213 F.2d 551, 102 USPQ 93 (CCPA 1954); *Andrews v. Wickenden*, 194 F.2d 729, 93 USPQ 27 (CCPA 1952); *In re Frey*, 182 F.2d 184, 86 USPQ 99 (CCPA 1950); *Thompson v. Hamilton*, 152 F.2d 994, 68 USPQ 161 (CCPA 1946). **The fact that the application claim may be broad enough to cover the patent claim is not sufficient.** *In re Frey*, 182 F.2d 184, 86 USPQ 99 (CCPA 1950).

Therefore, it is respectfully submitted that the present claims are not barred by 35 U.S.C. § 135(b)(2), since they do not seek to patent "the same ..., or for the same or substantially the same subject matter" as the prior published application. Whether the claims meet the two-way interference test of 37 C.F.R. § 41.203 is another matter entirely. Applicants have previously opined that the present claims do not meet that standard, though this is a determination for the Examiner and Board to decide.

It is noted that claim 126 does not directly correspond to any claim of Kerner et al., and in particular, the alignment system is not a claim element of Kerner et al.

Claim 139 recites a method similar (but not identical) to claim 16 of Kerner et al., and further “wherein said marking is controlled using feedback from an electronic imager and an output of an optical mapping system.” It is respectfully submitted that this represents an affirmative statement of function which is not present in, and distinguishes, the claims of Kerner et al.

Claim 154 provides a system corresponding to claim 1 of Kerner et al., “further comprising a base with said laser source and said beam orientation system mounted therein, the base having support surfaces for mounting thereon said optical diamond mapping apparatus, said computer means being capable of manipulating both said apparatus and said attachment.” It is respectfully submitted that this represents an affirmative statement of structure which is not present in, and distinguishes, the claims of Kerner et al.

Claim 165 provides a system similar to claim 16 of Kerner et al., further “wherein said marking is controlled using feedback from an electronic imager and an output of an optical mapping system.” It is respectfully submitted that this represents an affirmative statement of function which is not present in, and distinguishes, the claims of Kerner et al.

Claim 171 recites a method similar (but not identical) to claim 22 of Kerner et al., and further “wherein said pattern is a line generated based on a system for optically mapping the diamond, and wherein said marking is controlled using feedback from an electronic imager. It is respectfully submitted that this represents an affirmative statement of function which is not present in, and distinguishes, the claims of Kerner et al.

It is therefore respectfully submitted that the application is allowable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Steven M. Hoffberg".

Steven M. Hoffberg, Reg. 33,511

Milde & Hoffberg LLP
Suite 460, 10 Bank Street
White Plains, NY 10606
(914) 949-3100